

Inventor : Gordon et al.
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REMARKS

This amendment is responsive to the Office Action (hereinafter referred to as "the pending Action") mailed August 31, 2004. Claims 1-16 and 19-21 are under examination in the present action. Claims 3, 4, 6, 8 and 11 are listed as withdrawn from consideration. Claims 1, 2, 5, 7, 13, 15, 16, 20 and 21 stand rejected. Claims 9, 10, 12, 14 and 19 are listed as objected to. A copy of the PTO-1449 Form included with the Information Disclosure Statement submitted by Applicant on June 16, 2004, initialized by the Examiner to indicate her consideration of the documents indicated thereof, was made part of the pending Action.

Claims 1, 13, 15 and 20 have been amended as indicated above.

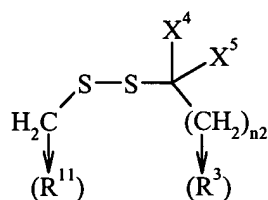
1. The Applicant is grateful for the withdrawal of "the improper Markush rejection" of claim 14 as detailed in the paragraph identified as "2)" in the Office Action mailed July 14, 2003.

2. The Applicant is grateful for the withdrawal of the 35 U.S.C. §112, second paragraph, rejection of claims 5, 7, 9, 10, 12-14 and 19 as detailed in the paragraph identified as "6)" in the Office Action mailed July 12, 2003.

3. The Applicant acknowledges that claims 3, 4, 6, 8 and 11 were withdrawn from further consideration pursuant to 37 C.F.R. §1.142(b) for being directed to an unelected

invention. Applicant is grateful for the Examiner's recognition on the record of Applicant's traversal of the restriction requirement.

4. Claims 1, 2, 5, 7, 15, 16, 20 and 21 stand rejected for being drawn to an improper Markush group. In support of this rejection, the Examiner argues that while "[t]he recited compounds, while possessing a common utility, differ widely in structure and are not art-recognized equivalents and are thus, independently distinct for the reasons set forth in the restriction requirement." In particular, the Examiner states that the "[t]he Markush group represented by the variables R^3 and R^{11} , where R^3 and R^{11}

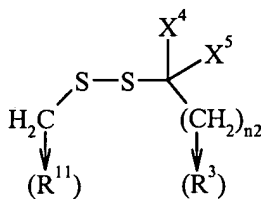


can be taken together to form have variably different definitions, rendering the claims clearly improper." Applicant respectfully disagrees.

Applicant submits that the *Markush* group recited in claim 1 is an acceptable alternative expression as provided for by MPEP §2173.05(h). The members of the subject *Markush* group all possess at least one property in common, i.e., a hydrocarbon, which is responsible for their function as claimed. Applicant asserts that the *Markush* group of claim 1 is recited in the conventional manner provided for in MPEP §2173.05(h) and that each member of the *Markush* group is

fully supported in the disclosure as required by MPEP §608.01(p). Applicant further contends that the members of the recited *Markush* group are sufficiently few in number as required by MPEP §803.02, even though they may be directed to independent and distinct inventions.

In an effort to advance the prosecution of this application, however, the Applicant proceeds on the assumption that the Examiner intended to reject claim 1 as being directed to unelected subject matter, see MPEP §706.03(m). Since the structure formed when R³ and R¹¹ can



be taken together to form $\text{(R}^{11}\text{)}$ $\text{(R}^3\text{)}$, results in a compound having a central imidazobenzodiazepine ring which is **not further fused**, like the 29th compound listed in original claim 14, the recited claim limitation results in a compound that is more consistent with the non-elected invention defined as Group II in the Office Action mailed November 13, 2002. In response thereto, the Applicant amends claim 1 to delete the objectionable limitation. Applicant submits that claim 1 is now in accordance with the election of Group I as defined in the Office Action mailed November 13, 2002. Applicant respectfully requests that the rejection of claim 1 be reconsidered and withdrawn.

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5. Claims 1, 2, 5, 7, 13, 15, 16, 20 and 21 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner sets forth her reasons for this rejection with particularity in subsections a) - e). In response, the Applicant responds as follows:

a). Claims 1, 2, 15, 16, 20 and 21 were found to be vague and indefinite due to an inconsistency between the definitions of R^6 and R^7 in claim 1 and the proviso clauses appended to said claim. Applicant recognizes the conflict, and in response thereto, has amended the definition of R^6 , restricting same to H or an aryl substituted with X^1 , X^2 and X^3 , and the definition of R^7 , restricting same to =O, -H, =S or an aryl substituted with X^1 , X^2 and X^3 . Applicant respectfully submits that the aforementioned amendments overcome the rejection of claims 1, 2, 15, 16, 20 and 21 as detailed in paragraph 5.a) of the instant Action and respectfully requests the withdrawal thereof;

b). Claims 1, 2, 5, 7, 15, 16, 20 and 21 were found to be vague and indefinite for not indicating the bonding of "-NCO- R^8 " in the definition of R^{30} . Without conceding the correctness of this rejection, Applicant has amended the definition of R^{30} in claim 1 by deleting "-NCO- R^8 " and inserting "-NH-CO- R^8 " to indicate that the unallocated bond of the nitrogen atom is bonded to a hydrogen atom.

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Applicant respectfully submits that one skilled in the art would readily understand that the nitrogen atom was bonded to the molecule, the carbonyl group and a hydrogen atom. Applicant respectfully requests the reconsideration and withdrawal of the subject rejection;

c). Claims 1, 2, 5, 7, 15, 16, 20 and 21 were found to be vague and indefinite for not indicating the bonding of "-NCO-R⁸" in the definitions of X¹, X² and X³. Without conceding the correctness of this rejection, the Applicant has amended the definitions of X¹, X² and X³ in said claim by deleting "-NCO-R⁸" and inserting "-NH-CO-R⁸" to better indicate that the unallocated bond of the nitrogen atom is bonded to a hydrogen atom. Applicant respectfully submits that one skilled in the art would readily understand that the nitrogen atom was bonded to the molecule, the carbonyl group and a hydrogen atom and as such respectfully requests the reconsideration and withdrawal of the subject rejection;

d). Claim 13 was found to be vague and indefinite for use of "[1,2a]" in the nomenclature of the species. Without conceding the correctness of the Examiner's rejection, claim 13 has been amended by deleting all occurrences of the "[1,2a]" and replacing same with "[1,2-a]" as suggested by the Examiner. Applicant respectfully requests the reconsideration and withdrawal of the subject rejection;

e). Claim 20 was found to be a "substantial duplicate of" claim 15 due to only difference between said claims

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being a statement of intended use which, according to the Examiner relying on the decision of *In re Tuominen*, 213 USPQ 89, is not given material weight. Applicant respectfully disagrees. Claims 15 and 20 have been amended to better distinguish one claim over the other. As such, claims 15 and 20 are in compliance with the *Tuominen* decision and the Applicant respectfully requests reconsideration and withdrawal of the subject rejection.

6. Claims 15 and 16 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 10 and 14 of co-pending application USSN 10/129,569 (hereinafter referred to as "the '569 application"). Applicant contends that claims 15 and 16 of the present application are patentability distinct from claims 1, 2, 10 and 14 of the '569 application.

The present claims are directed to the treatment of a number of conditions, including several forms of cancer, related to the overproduction of prenyl transferase enzymes, by certain novel compounds discovered to inhibit such enzymes. The '569 application is directed to the treatment of cancer with a composition comprised of at least one transduction inhibitor of heterotrimeric G protein signals combined with at least one other anti-cancer agent. It is well established that a combination of two known entities is patentable. As stated in MPEP §804, the analysis employed

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in an obviousness-double patenting determination parallels the guidelines for a 35 U.S.C. §103(a) rejection.

Applicant contends that the present application clearly does not teach, suggest or infer that a combination of the present compounds with a transduction inhibitor of heterotrimeric G protein signal, produces a therapeutic compound for the treatment of cancer. The '569 application does not teach or suggest the disclosure found at pages 16, line 6 to page 17, line 2, which enables one skilled in the art to practice claims 15 and 16. It should be noted that the MPEP suggests that double patenting is evident when the subject application contains a disclosure which complies with 35 U.S.C. §112, second paragraph, for the claims of the co-pending application. Clearly claims 15 and 16 of the present application would be rejected under 35 U.S.C. §112, second paragraph, if combined with the disclosure of the '569 application and claims 1, 2, 10 and 14 of the '569 application would be rejected, under 35 U.S.C. §112, second paragraph, if combined with the disclosure of the present application. As such, the Applicant contends that this rejection is improper, lacks merit and should be withdrawn.

7. Applicant acknowledges the objection to claims 9, 10, 12, 14 and 19 as being dependent upon a rejected base claim and appreciates the opportunity to amend said claims in independent form. Applicant respectfully declines the Examiner's invitation to amend said claims on the belief

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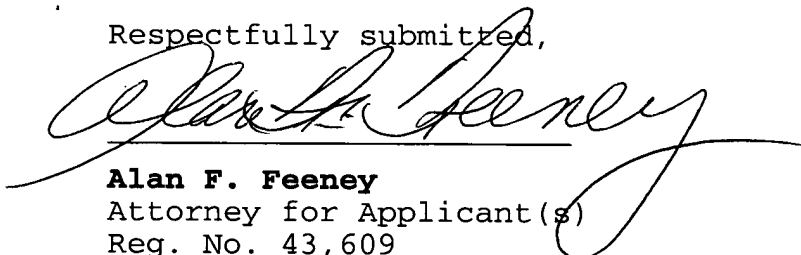
that the above amendments put the subject base claims in a condition for allowance. Applicant respectfully requests a final opportunity to amend claims 10, 12, 14 and 19 at a later date if the Examiner finds that the amendments of the base claims do not overcome the stated rejections.

Applicant respectfully submits that the pending claims are in a condition for allowance and notification to that effect is earnestly solicited. Examiner Coleman is invited to telephone Applicants' attorney at (508) 478-0144 to facilitate prosecution of this application. Please apply any charges or credits to Deposit Account No. 50-0590 referencing attorney docket number 00537-188002.

Date: 2/28/2005

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Respectfully submitted,


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